UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,486	11/03/2000	Joseph Gendler	P/2167-166	7644

7590	11/25/2003

Edward A. Meilman, Esq.
Dickstein Shapiro Morin & Oshinsky LLP
1177 Avenue of the Americas - 41 st Floor
New York,, NY 10036-2714

EXAMINER
SHAFFER, ERIC T

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Office Action Summary	09/705,486		GENDLER, JOSEPH
	Examiner		**Art Unit**
	Eric T. Shaffer		3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 September 2003</u> .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-67</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-67</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   This communication is in response to the amendments filed September 23, 2003.

Summary of Instant Office Action

2.   Applicant's arguments, filed September 23, 2003, concerning the claims 1 – 67 in the

Office Action mailed February 19, 2003 have been considered and deemed unpersuasive.

    None of the old claims have been cancelled by the applicant and the applicant has added

no new claims. Claims 1 – 67 are pending and are prosecuted in the response set out below. The

objections expressed as per the misnumbered claims have been removed.

Claim Objections

3.   The claim objections to the mis-numbering of claim 57 and in the claim language of

claims 58 – 67 has been corrected by the applicant and therefore the objection is hereby

removed.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (e) the invention was described in a patent granted on an application for patent by
> another filed in the United States before the invention thereof by the applicant for patent,
> or on an international application by another who has fulfilled the requirements of
> paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by
> the applicant for patent.

5.   Claims 1 – 5, 7 – 15, 17 – 29, 35 – 50, 52 – 64, 66 and 67 are rejected under 35

U.S.C. 102(e) as being anticipated by Mora et al (US 6,161,113).

Claims 1, 2, 17, 35 and 37 are a method and a system for automating the management of

a project. A project management system is anticipated by Mora et al., which discloses a system

that incorporates "Project Mgt Priorities--description of the project management's priorities for

the project and long-range plans" (column 10, line 45 - 48). The method comprising the steps of:

generating at least one electronic document associated with the project; Generating

electronic documents is anticipated by Mora et al., which discloses "Pre-composed forms

provide a basic sequential structure for project documentation. These forms are stored as

Methodology documents in the Management and Technical databases. These forms are included

in the notebook upon initialization of a particular project, and are immediately available to the

user via a menu selection" (column 19, lines 42 - 45).

identifying entities that comprise an approval hierarchy; Parties identified and their

individual documents being generated is anticipated by Mora et al., which discloses four levels

of approvals as "Authorization to Proceed – this document records the senior executive review of

approval to continue with the project" (column 10, lines 1 - 2), (column 10, lines 52 - 53),

(column 12, lines 23 - 24) and (column 13, lines 9 - 10).

automatically forwarding a notice requesting approval of the at least one electronic

document to a successive one of the entities in the approval hierarchy upon approval of the at

least one electronic document by a previous entity in the approval hierarchy. Forwarding a non-

ratified contract that is to be approved through an approval hierarchy is anticipated by Mora et

al., which discloses "programming for a display that prompts a user to enter a request for

signatures for a document and that generates a signature request document in response to said

request for approval" (column 59, lines 41 - 45).

a first one of the entities or a previous entity in the approval process requesting

clarification with respect to the at least one electronic document; Requesting clarification and/or

resolving by way of facilitating an open discussion of disputes is anticipated by Mora et al.,

which discloses "Discussion – a generic form to allow users to enter into an electronic discussion

about a topic" (column 15, lines 7 – 8).

second one of the entities in the approval process disapproving the at least one electronic

document; A second entity in the approval/disapproval process, other than senior management,

is anticipated by Mora et al., which discloses "This field contains the name of the customer

representative. This person will have the authorization to approve the Customer section of

document approvals, reviews, and ATPs" (Figure 5).

6.   **Claims 3 and 38** are a method and a system further comprising the steps of:

opening an electronic notebook associated with the at least one electronic document; An

electronic network form is anticipated by Mora et al, which discloses "the project notebook

forms may be pre-composed or user – composed. Both types of forms are stored" (column 4,

lines 26 - 29).

generating the requested clarification in the electronic notebook; Requesting clarification

and/or resolving by way of facilitating an open discussion of disputes is anticipated by Mora et

al., which discloses "Discussion – a generic form to allow users to enter into an electronic discussion about a topic" (column 15, lines 7 – 8).

forwarding the at least one electronic document back to the entity that requested the clarification. Forwarding of documents is anticipated by Mora et al, which discloses "the form can be sent through e-mail" (column 16, lines 8 - 9).

7.   **Claims 4 and 39** are a method and system further comprising the steps of:

one of the entities in the approval process disapproving the at least one electronic document; Approving or not approving, which is disapproving, is anticipated by Mora et al., which discloses "Approvals-Automated and controlled signature form for required signoffs" (column 11, lines 53 - 54).

automatically forwarding the at least one electronic document to one of a previous entity in the approval hierarchy and the document originator. Forwarding an electronic document, such as a contract, is anticipated by Mora et al., which discloses "programming for a display that prompts a user to enter a request for signatures for a document and that generates a signature request document in response to said request for approval" (column 59, lines 41 - 45).

8.   **Claims 5 and 40** are a method and system further comprising the step of determining if a monetary value associated with the at least one electronic document requires that at least one electronic document obtain the approval of a higher level entity in the approval hierarchy. Determining a monetary value or payment details and identifying the approval contracting

parties is anticipated by Mora et al. which discloses "the official form that is used to request additional money for the project once the project has begun" (column 11, lines 5 - 7).

9.   **Claims 7 - 15 and 42 - 50** are methods and system further comprising the step of maintaining the at least one electronic document in a central storage location to which the entities in the approval hierarchy can access, review and approve the at least one of several types of electronic document. A database of electronic documents in a central location is anticipated by Mora et al., which discloses "a Division Documents database" (column 3, line 35).

10.   **Claims 18, 24 and 52** are a method and system, wherein there are a plurality of electronic documents, the method further comprising the steps of organizing the plurality of electronic documents into folders; use of drag and drop, and providing a plurality of views of the plurality of electronic documents. Folders and drag and drop are anticipated by Mora et al, which discloses folders as "various menus and other windows-type user prompts, such as buttons and dialog boxes" (column 2, lines 58 - 60), and views is taught as "the forms are categorized into views, each view having different view selection criteria" (column 1, lines 53 - 54).

11.   **Claims 19 and 53** are a method and system further comprising the steps of establishing a user profile for each user participating in the method and limiting a user's access to the at least one electronic document based on a parameter in the user profile. Limiting a user's access to a specific set of documents is anticipated by Mora et al., which discloses "the notebook software contains pre-programmed formulas that determine which persons may access or enter data into which forms or sections of forms. In other words, document security is provided on a form-by-

form basis" (column 6, lines19 - 22) and "document security is based on the project roles, whose

assignment was discussed above in connection with project initialization" (column 6, lines 28 -

31) where "the database manager defines the access control list (ACL). The ACL specifies

which users, user groups, and servers have access to the project-specific database and what tasks

these persons can perform. The access levels include manager, designer, editor, author, reader,

depositor, and no access" (column 5, lines 50 - 55).

12.   **Claims 20 and 54** are a method and system further comprising the step of generating an

electronic workflow list for a user that contains a list of electronic documents that require an

action by the user. An electronic list or directory of items or views that require a change status

action by the user is anticipated by Mora et al., which discloses a "The user has made a View

selection to access a list of documents. From this list, the user has selected a document

whose status is to be changed." (column 7, lines 24 - 28).

13.   **Claims 21, 55 and 56** are a method and system wherein the step of automatically

forwarding the notice further comprises forwarding the notice on an intranet. Sending a notice

via an Internet address is anticipated by Mora et al., which discloses "system may also be part of

a larger network via external connections to the Internet" (column 3, lines 24 - 25).

14.   **Claims 22, 23, 58 and 59** are a method and system further comprising the steps of:

        generating a budget for the project;. Determining how much to pay each party is

anticipated by Mora et al., which discloses "Estimating process - description of the process and

assumptions used in creating the estimates for the project" (column 10, lines 37 - 38).

and generating a funding document using the budget, wherein the at least one electronic

document is the funding document. Creating a budget funding document is anticipated by Mora

et al., which discloses "details of the work breakdown structure (task list), budget required, and

schedule for the project" (column 10, lines 40 -43).

15.   **Claims 25 – 29 and 60 – 64** are methods and systems incorporating an electronic file.

An electronic file or database record is anticipated by Mora et al., which discloses a "notebook

database is composed of five databases: a management database, a technical database, a division

documents database, an administration database" (column 3, lines 33 - 36).

16.   **Claim 36** is a system for automating the management of a project, the system

comprising:

a network; A network in the form of a Local Area Network (LAN) or a Wide Area

Network (WAN) is anticipated by Mora et al., which discloses a "system is comprised of a server

11 in data communication with a number of workstations 11 via some sort of protocol such as

that provided by a LAN or WAN connection. Server 11 may be connected to other servers, as

part of either a flat or hierarchal network structure." (column 3, lines19 - 24) .

a project manager workstation coupled to the network; A project management

application that runs on a notebook workstation is anticipated by Mora et al., which discloses "to

initialize a project notebook, a project manager makes project-specific copies of the Management

and Technical databases, and gives the new databases a project identifier." (column 5, lines 45 -

48).

at least one client workstation coupled to the network, wherein the at least one client

workstation is used to identify entities that comprise an approval hierarchy; A workstation

coupled to a network is anticipated by Mora et al., which discloses "system 10 is comprised of a

server in data communication with a number of workstations 12, via some sort of protocol such

as that provided by a LAN or WAN connection" (column 3, lines 19 – 22).

a database server coupled to the network, the database server containing at least one

electronic document associated with the project; A database of documents coupled to a network

server is anticipated by Mora et al., which discloses a "server 11 is comprised of a computer

11a, which in addition to its other server tasks, maintains a notebook database 11b" (column 3,

lines 30 - 32).

a workflow server coupled to the network wherein the workflow server automatically

forwards a notice requesting approval of the at least one electronic document to a successive one

of the entities in the approval hierarchy upon approval of the at least one electronic document by

a previous entity in the approval hierarchy. A server connected to a network is anticipated by

Mora et al., which discloses "programming for a display that prompts a user to enter a request for

signatures for a document and that generates a signature request document in response to said

request for approval" (column 59, lines 41 - 45).

17.   **Claims 57, 66 and 67** are the system as recited in claim 65 wherein the external network

is the Internet. Internet capability is anticipated by is anticipated by Mora et al., which discloses

"system may also be part of a larger network via external connections to the Internet" (column 3,

lines 24 - 25).

Claim Rejections - 35 USC § 103

18.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

19.   **Claims 6, 16, 30 – 34, 51 and 65** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Mora et al (US 6,161,113) in view of Webber Jr. (US 6,167,378).

Mora et al teaches a project notebook with a database of pre-composed documents used

to manage a project and to obtain approval from senior management during various phases of the

project. The device incorporates LAN, WAN and Internet access and also includes a windows

based interface. Mora also teaches a pre-programmed feature for automatically obtaining

approval.

Mora et al does not specifically teach digital signatures or an interface with accounting

software such as the General Ledger.

Webber Jr. teaches an automated network and Internet based project management and

contract management system that incorporates electronic documents and an approval hierarchy,

digital signatures, financial / General Ledger interactions and a database. As per Claims 16 and

51, Webber Jr., also teaches digital signatures by reciting "the ratifying step is a digital

signature" (column 25, lines 64 - 65). As per Claims 30 – 34 and 65 Webber Jr. also teaches

General Ledgers and performing a partial and/or full closeout to the General Ledger by transfer

of ending financial balances, via making the appropriate debit/credit journal entries to the

General Ledger, by reciting "all data for all transactions, journals, ledgers, financial reports, and

management reports for a particular party may be viewed by that party via a connection to the CAP" (column 11, lines 28 -31) and where "the database includes storage for records of calculated payables for payment from the second entity to the first" (column 27, lines 49 -51). Webber Jr. also teaches that "a digital contract is executed by any acceptable means, including digital signatures or automatic ratification" (column 9, lines 47 - 49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate digital signatures because digital signatures would increase the speed and efficiency with which the approval process was performed. Without incorporating digital signatures, the invention would require the use of standard written signatures, which would require that the signature either be scanned and fed into the system or would require the incorporation of handwriting software which at the time of the invention had not yet been perfected. Digital signatures would eliminate this step and lead to quicker approval from the many people within the approval hierarchy.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate financial measures, calculation of payments and General Ledger entries because such measures convey to both the project manager and to the customer the degree to which the goals of the managed project are being met. The willingness of the customer to make payment in a timely and accurate manner demonstrates that a customer is happy with the project. Determination of a project being under or over budget is also an indicator of the successful or failure of a project. Meeting specific percentage of completions in a timely manner also present a success measure of the project at specific points in time.

Therefore, incorporating financial and General Ledger numbers is an obvious way to determine how well the project is going and an essential part of the project management system.

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to take the signature request document that is forwarded with the click of a button via the Mora et al device and combine it with the automatic ratification execution of the Webber Jr. device in order to create a device that would allow persons in the approval hierarchy to automatically approve any document that met with a specific set of given criteria. It would be obvious to do this in order to improve the speed and efficiency with which items are approved. Thus it would only be necessary to have items that are flagged due to a certain criteria to be set aside for review by humans within the approval hierarchy. This would free up the members of the approval hierarchy from the mundane task of reviewing standard or non-exceptional items and allow said hierarchy to concentrate on those items that warrant further attention.

Response to Amendments

20.   Applicant's arguments filed September 23, 2003 have been fully considered, but the same are not persuasive.

a)   Applicant argues that Mora et al does not teach automatically forwarding a notice requesting approval of an electronic document. However Mora does in fact teach a feature where the approval of an electronic document is sought automatically, wherein "Methodology documents whose status has been changed to Pending Approval have a pre-programmed feature for automatically obtaining approval" (column 7, lines 43 - 47). This

feature does in fact automatically forward a notice for requesting approval automatically as part of a pre-programmed pre-approval process.

b)   Applicant argues that Mora et al does not teach automatic forwarding the notice requesting a signature for persons in an approval hierarchy. Mora teaches the forwarding of approval documents by reciting, "If a user activates this button, the notebook process creates a Signature Request document that is sent to the required signatories. The Signature Request document prompts the signatories to review and approve the associated document" (column 7, lines 48 - 52). Webber Jr. further teaches the execution of a digital contract for automatic ratification. The combination of the Mora et al and the Webber Jr. teach the automatic forwarding of the notice for requesting approval and would be obvious to one of ordinary skill in the art because the ability to automatically pre-approve items based on a pre-determined set of criteria would free up the members of the approval hierarchy from spending time on the approval of mundane items and allow them to concentrate their approval efforts on items requiring special attention.

c)   Applicant argues that claims 16, 30-34, 51 and 65 are dependent on the previously discussed independent claims and if the independent claims are patentable, then the dependent claims are also patentable. Since the independent claims are not patentable, the afore mentioned dependent claims are also not patentable.

In light of above stated facts, examiner respectfully states that applicant's arguments have been fully considered, deemed unpersuasive and the rejections under the prior Office Action, mailed February 19, 2003 are maintained.

Conclusion

21.   THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the

extension of time policy as set forth in 37 1.136(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS

from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the

mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory

period for reply expire later than SIX MONTHS from the date of this final action.

22.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The

Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax number for the organization

is (703) 305-0040/308-6306

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Receptionist whose telephone number is (703) 305-3900.

Eric Shaffer

November 21, 2003

SusannaDaz
Primary Examiner
A.U. 3623